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In re Application of:	:	
MASON, Rex, Allan	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/576,705	:	37 CFR 1.47(b)
PCT No.: PCT/NZ2004/000259	:	
International Filing Date: 15 October 2004	:	
Priority Date: 21 October 2003	:	
Attorney's Docket No.: JAMES117.001APC	:	
For: ANTI-FOAMING DEVICE	:	

This decision is issued in response to the "Petition Under 37 CFR 1.47(b)" filed 19 July 2007. Petitioner has filed the required petition fee.

BACKGROUND

On 15 October 2004, applicant filed international application PCT/NZ2004/000259. The application claimed a priority date of 21 October 2003, and it designated the United States. On 28 April 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 21 April 2006.

On 20 April 2006, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the small entity basic national fee.

On 20 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497 was required.

On 19 July 2007, petitioner filed a response to the Notification Of Missing Requirements, with required two-month extension fee. The response included the petition under 37 CFR 1.47(b) considered herein, which seeks acceptance of the application without the signature of the inventor, whom petitioner states has refused to execute the application papers.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be

reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present submission satisfies items (1), (3), and (4).

Regarding item (1), petitioner has submitted the required \$200 petition fee. Item (1) is therefore satisfied.

Regarding item (2), where it is asserted that the an inventor has refused to execute the declaration, section 409.03(d) of the MPEP states that a “copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also requires “a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.” Here, petitioner has provided a statement from Sandra Jo Wilcocks, with accompanying exhibits, as evidence of the efforts to obtain the signature of the non-signing inventor on the declaration. The exhibits include copies of the following relevant correspondence: (a) a letter mailed to the non-signing inventor's attorney requesting his signature on the declaration and separate “Deed of Assignment” document; (b) a response from the inventor's attorney setting forth an objection to the language in the Deed of Assignment and stating that, once this language was corrected, the inventor would execute the Deed and the USA Power of Attorney (i.e., the declaration); (c) a responsive letter to the inventor's attorney discussing the Deed of Assignment (but not the declaration); (d) a letter from the inventor's attorney stating that the comments regarding the Deed of Assignment had been forwarded to the inventor; (e) a letter to the inventor's attorney, dated 29 May 2007, requesting the inventor's signature on the declaration and on a general assignment; this letter states that it included a copy of the complete application. No response to this final letter had been received at the time the present petition was filed.

The materials filed herein are not sufficient to confirm that the non-signing inventor has refused to sign the declaration in the present application. While the inventor has not provided the requested declaration, the present record does not include a request for the inventor to execute the declaration which is not combined with a request to execute the disputed Assignment document (the document which the inventor has expressly refused to sign). Petitioner must provide a proper showing confirming that the inventor has refused such a request before it can be concluded that the inventor has refused to execute the declaration herein; evidence should also be provided regarding any response that has been received from the inventor or his attorney with respect to the 29 May 2007 letter. Based on the above, on the present record, item (2) is not satisfied.

Regarding item (3), the petition includes an express statement of the last known addresses of the non-signing inventor. Item (3) is satisfied.

Regarding item (4), the petition includes a declaration executed on behalf of the non-signing inventor by a representative of the 37 CFR 1.47(b) applicant, Eliminator Holdings Ltd (“Eliminator”). Item (4) is therefore satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner here asserts that it has the required proprietary interest based on an "Agreement" between Vergence Holdings Limited ("Vergence") and the inventor (Vergence is the former name of 37 CFR 1.47(b) applicant Eliminator), as well as a statement executed by the inventor in which he confirms that he has "disposed of my Intellectual Property for the Eliminator to Eliminator Holdings Limited (Previously known as Vergence Holdings Limited) and confirm that I have no further personal rights to the Eliminator Intellectual Property." However, on the present record, these materials cannot be interpreted as representing an assignment of the invention underlying the present application, or an agreement to assign such invention. Specifically, the materials do not refer to the underlying priority application (which was filed well before these materials were executed and therefore could have been listed, if the materials were intended to cover such application), nor is "the intellectual property rights in the Eliminator" referred to in such materials a specific enough description of the transferred property to permit the USPTO to conclude, on the present record, that the invention underlying the present application was assigned pursuant to such materials (See MPEP 409.03(f): The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant).¹

Absent an acceptable assignment or agreement to assign, petitioner must demonstrate a proprietary interest in the application obtained other than through direct assignment or an agreement to assign. The requirements for such a showing are also set forth in the MPEP:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision

¹ Paragraph 12 of the statement of Sandra Wilcocks asserts that "it would have been understood by all parties at the date of execution of this agreement that the Eliminator Intellectual property referred to" included the patent portfolio including the present application. However, this unsupported statement from a non-party to the agreement is insufficient to support a conclusion that the agreement provided encompasses the present application.

(if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner here has not provided a legal memorandum demonstrating that 37 CFR 1.47(b) applicant Eliminator has a proprietary interest in the invention based on applicable law.

Based on the above, item (5) is not considered satisfied on the present record.

Regarding item (6), the petition does not include the required statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is therefore not satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy items (2), (5) and (6) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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